REMARKS

In an Office Action mailed on July 25, 2005, certain objections were raised to the abstract and cross-reference to related applications. Claims 1-5 were rejected under 35 U.S.C. § 103(a). Applicant respectfully disagrees. Applicant has amended the abstract as requested by the Office Action. As also requested by the Office Action, applicant has amended the cross-reference to related applications to now include the recitation to U.S. Patent No. 6,648,344. Applicant thanks the Examiner for pointing out the deficiencies in the application.

Claims 1 and 4 have been amended above to clarify the subject matter of the present application. For at least the reasons set forth below, applicant respectfully submits that amended Claims 1 and 4 are now in condition for allowance.

Claim Rejections under 35 U.S.C. § 103

To establish a *prima facie* case for obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142 (August 2005).

Claims 1 and 4, as well as certain dependent claims stemming therefrom, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,732,958, issued to Liu, in view of U.S. Patent No. 5,625,999, issued to Buzza et al. The Office Action sets forth the position that although Liu teaches the basic claimed process of making a skate frame, it does not teach a second outer layer and a decorative layer. Buzza et al. is cited by the Office Action as teaching an outer decorative gel layer and, therefore, it would have been obvious to provide the decorative layer and additional inner fiber reinforced resin layer, as taught by Buzza et al. to the

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process of Liu. Applicant disagrees because (1) Buzza et al. is a non-analogous patent; and (2) the hypothetical combination of Liu and Buzza et al. fail to teach or suggest all limitations of amended Claims 1 and 4.

According to MPEP 2141.01(a), it is well settled that "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *See e.g. In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Applicant respectfully submits that the invention of Buzza et al. is neither in the field of applicant's endeavor nor pertinent to the particular problem with which the applicant was concerned.

Buzza et al. concerns a roofing system that includes a fiberglass sandwich panel 100 formed from a molding process. A plurality of fiberglass sandwich panels 100 are attached and assembled to structural steel purlins to form a roofing system. Buzza et al. does not concern molding a core within reinforced layers to produce a strong, lightweight skate frame, as taught by amended Claims 1 and 4. Thus, the method of Buzza et al., which includes making a fiberglass sandwich panel for a roofing system, is not reasonably pertinent to the Lui lay up process or the method of forming a skate of the present claims.

Applicant also notes that Buzza et al. is also not pertinent to the particular problem which the applicant was concerned. As noted in the application as filed, the presently claimed methods of manufacturing an in-line skate frame addressed various issues associated with then existing methods of manufacturing such skate frames. As a non-limiting example, because then existing methods of manufacturing in-line skate frames utilized a "flange extending laterally away from both sides of the upper end of the skate frame," such skate frames were not "very robust in

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accommodating different skating styles, even for the skater for whom the skate was custom made." (See page 2, line 24 though page 3, line 2).

In contrast, the problem addressed by Buzza et al. dealt with lightweight roofing systems. It is noted that Buzza et al. expressly criticized several prior art patents dealing with roofing systems comprising a plurality of fiber glass sandwiched panels. (Col. 2, lines 38-40). Buzza et al. criticizes the prior art patents for failing to "suggest the use of a sandwich panel having two substantially parallel surfaces and a peripheral edge having a step shape or a roofing system comprising sandwich panels having two shapes with relative dimensions joined at ship-lap joints." (Col. 2, lines 40-44).

Thus, the problems addressed by Buzza et al. are generally directed to lightweight roofing systems. Applicant respectfully submits that because Buzza et al. is neither in the field of applicant's endeavor or pertinent to the particular problem which the applicant was concerned, is respectfully submitted that Buzza et al. is non-analogous prior art. As a result, the hypothetical combination suggested in the Office Action to render the claims of the present application unpatentable under 35 U.S.C. § 103 is improper.

Even assuming that Buzza et al. is deemed to be analogous prior art, applicant respectfully submits that a hypothetical combination of Liu and Buzza et al. fails to teach or suggest each and every aspect of amended Claims 1 and 4. In that regard, the hypothetical combination fails to teach or suggest a method of constructing a skate frame that includes positioning core material on the first skin so that the core material is "substantially absent from areas adjacent the shoe load introduction portion," as is now generally recited in amended Claims 1 and 4.

Lui teaches a skate frame with an inverted U-shaped outer case 20 that receives an inner member 30. The outer case includes an upper plate 21 and two sidewalls 22. The inner

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member 30 is securely disposed between the two sidewalls 22 of the outer case 20. As shown in FIGURE 2, the top surface of the inner member 31 abuts the inside surface of the upper plate 21 of the outer case 20. During the molding process, the inner member 30, or core, is positioned beneath the upper plate 21 that inherently received loads from the boot 50 when it is attached to the upper plate 21 of the molded frame (see FIGURE 3). Thus, Liu fails to teach or suggest a method of manufacturing an in-line skate frame that generally includes positioning core material on a first skin such that the core material is "substantially absent from areas adjacent the shoe load introduction portion," as generally recited in amended Claims 1 and 4.

Buzza et al. does not teach or suggest what is missing from Lui. Buzza et al. discloses a fiberglass sandwich panel 100 that includes a top and bottom gel coat resin 24 and 14, a top and bottom fiberglass skin 22 and 16 inside the gel layer, and an inner foam core 20 inside the fiberglass skin. The layers are bonded integrally together during the fabrication of the fiberglass sandwich panel 100 in a heated mold. The core conforms to the shape of the mold; therefore, the fiberglass sandwich panel 100 substantially conforms to the shape of the core. As a result, the core is positioned within the fiberglass skin layers such that the core is exposed to loads imposed on the fiberglass sandwich panel 100. Thus, Buzza et al. fails to teach or suggest a method of manufacturing a skate frame that includes positioning core material such that it is "substantially absent from areas adjacent the shoe load introduction portion," as generally set forth in amended Claims 1 and 4.

As noted above, there is no teaching or suggestion within either Liu or Buzza et al. to combine the two teachings as suggested by the Office Action. Moreover, such a hypothetical combination fails to teach or suggest all of the claim limitations of amend Claims 1 and 4. Accordingly, it is respectfully submitted that the hypothetical combination of Liu and Buzza et al. is improper under 35 U.S.C. § 103 and, therefore, should be withdrawn.

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The dependent claims of the present application stem from amended Claims 1 or 4 and, therefore, are patentable. In addition, each dependent claim has patentable subject matter over the cited references of record, including the hypothetical combination of Liu and Buzza et al. Accordingly, all claims are now in condition for allowance.

The Examiner is invited to telephone the undersigned with any remaining issues regarding this matter.

Respectfully submitted,

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